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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/652,923	08/29/2003	Charles E. Eller	0123324	2482
49328	7590	06/07/2006	EXAMINER	
BRYAN CAVE LLP 211 NORTH BROADWAY SUITE 3600 ST. LOUIS, MO 63102-2750			HARMON, CHRISTOPHER R	
			ART UNIT	PAPER NUMBER
			3721	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/652,923	ELLER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Christopher R. Harmon	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 26,27,32 and 33 is/are allowed.
- 6) ☐ Claim(s) 1-13,15-18,21-25 and 28-31 is/are rejected.
- 7) ☐ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____.  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____.   | 6) <input type="checkbox"/> Other: ____.                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/27/06 has been entered.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 4, 7, 11, 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Miura et al. (US 5,080,023).

Miura et al. disclose a container carrier system comprising pallet defining a plurality of compartments; a plurality of pucks removably attached to the pallet. The pucks are considered removably held by a compartment when it is desired to restrict the space of a first-sized compartment by the addition of another puck (redefining the compartment size for a second-size container) see figures 9-11. Limitations such as "adapted to", "structured to be", etc. (claim 1, lines 4-5) present capability issues only. The system of claim 1 does not require any automation, it only requires a pallet

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structure capable of being used in a automated process. Note: a limitation directed to an intended use of an apparatus or a process requires a structural difference or a manipulative difference between the claimed invention and the prior art. See *In re Otto*, 312 F.2d 937, 938, 136 USPQ 458, 459 (CCPA 1963); *In re Sinex*, 309 F.2d 488, 492, 135 USPQ 302, 305 (CCPA 1962); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed.Cir. 1997).

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3, 5, 6, 8, 9, 10, 12, 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miura et al. (US 5,080,023) in view of Lasher et al (#5,771,657).

Miura et al. substantially show the claimed subject but do not show a pallet conveyor as well as the various known components in the prescription filling operation. Lasher teaches the basic concept of loading multiple pallets with prescription filling bottles on conveying system 21 to move the carriers for filling, carrier identification tags wherein each bottle is positioned in a carrier based on the tag information. Lasher discloses a robotic arm 79, which reads on a picker mechanism to pick up designated containers for loading. Lasher shows the concept of loading a plurality of containers on

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different pallets for loading containers on the carriers as well as unloading containers on the carriers.

It would have been obvious to provide the carrier means of Miura et al. with the various components in prescription filling of Lasher et al to fill prescriptions in bottles as is known in the art. Regarding the picker mechanism picking up pucks as opposed to the containers that are picked up by Lasher et al., the examiner notes that expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. See ex parte Thibault, 164 USPQ 666, 667 (Bd App. 1969). Furthermore, inclusion of material or article worked upon by a structure being claimed does not impart patentability to the claims. In re Young, 75 F.2d 996, 25 USPQ 69 (CCPA 1935) (as restated in re Otto, 312 F.2d 937, 136 USPQ 458, 459 (CCPA 1963). Regarding the tag for storing information relating to the puck configuration, Lasher et al show the use of tags to store information relating to the carrier configuration and the examiner cites that inclusion of material worked upon by a structure being claimed does not impart patentability as discussed supra.

6. Claims 17, 18, 21-25, 28-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lasher (US 5,771,657) in view of Levey et al. (US 5,566,695) or Miura et al. (US 5,080,023).

Lasher et al teach the basic concept of loading multiple pallets with prescription filling bottles on conveying system 21 to move the carriers for filling, carrier identification

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tags wherein each bottle is positioned in a carrier based on the tag information. Lasher et al disclose a robotic arm 79, which reads on a picker mechanism to pick up designated containers for loading. Lasher shows the concept of loading a plurality of containers on different pallets for loading containers on the carriers as well as unloading containers on the carriers.

Lasher et al do not show the concept of having a carrier with multiple different pucks to accommodate different sized containers. However, Levey et al. and Miura et al. show the concept of having a pallet with various sized pucks to accommodate different sized containers.

Levey et al show a container carrier system comprising: a pallet structure as shown in fig 2, a plurality of pucks 33 that are removeably loaded onto the pallet to adapt a compartment to hold a plurality of container sizes as shown in figs 3a-3e. Levey et al disclose that a variety of different inserts can be provided to accommodate different container sizes to allow for different spacings between containers (Col 5 lines 23+). The pucks are loaded and unloaded on the pallets to change the pucks to accommodate different sized containers.

It would have been obvious to one of ordinary skill in the art at the time of the invention to provide Lasher with different pucks on a pallet as taught by either Levey et al. or Miura et al. to accommodate different sized containers for flexibility/adjustability in the filling operation. Both inventions to Levey et al. and Miura et al. are fully capable for use in an automated system such as that provided by Lasher et al.

***Allowable Subject Matter***

7. Claim 14 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Claims 26-27 and 32-33 are allowed.

***Response to Arguments***

9. Applicant's arguments filed 3/27/06 have been fully considered but they are not persuasive. Regarding the argument that the automatic configuration allows for multiple container sizes to be held at the same time, both Levey and Miura have sufficient structure to allow for holding multiple sizes of containers at the same time.

Note that while features of an apparatus may be recited either structurally or functionally, claims directed towards an apparatus must be distinguished from the prior art in terms of structure rather than function. See *In re Schreiber*, 128 F.3d 1473-78, 44 USPQ2d 1429-32 (Fed.Cir. 1997) and *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed.Cir. 1990).

***Conclusion***


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher R. Harmon whose telephone number is (571) 272-4461. The examiner can normally be reached on Monday-Friday from 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Chris Harmon  
Patent Examiner